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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,756

03/10/2004

Daniel James Plant

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03/09/2009

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SUITE 420  
MELVILLE, NY 11747

EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

03/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/797,756	<b>Applicant(s)</b> PLANT, DANIEL JAMES	
	<b>Examiner</b> Cheryl Juska	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 62-74 and 76-99 is/are pending in the application.
- 4a) Of the above claim(s) 71, 72 and 76-99 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 62-64, 69, 73 and 74 is/are rejected.
- 7) ☐ Claim(s) 65-68 and 70 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**SUPPLEMENTAL  
DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 15, 2008, has been entered.

***Response to Amendment***

2. Applicant's amendment filed on September 15, 2008, has been entered. Claims 62, 73, and 74 have been amended as requested. Additionally, the specification has been amended as requested. Claims 1-61 and 75 have been cancelled. Thus, the pending claims are 62-74 and 76-99, with claims 71, 72, and 76-99 being withdrawn as non-elected.

3. Said amendment is sufficient to overcome the objection to claims 62, 73, and 74 as set forth in section 5 of the last Office Action (Final Rejection mailed 04/19/07). Additionally, the cancellation of claim 75 renders moot the 101 double patenting rejection as set forth in sections 6 and 7 of the last Office Action.

4. Said amendment, with arguments, is also sufficient to overcome the rejections based upon US 2005/0037189 issued to Palmer et al. as set forth in sections 11 and 13 of the last Office

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Action (Final Rejection mailed 04/19/07). Specifically, the present application is granted priority as a continuing application of International Application PCT/GB02/04209. See MPEP 1895.01. Additionally, the present application is granted priority to the PCT's priority documents, GB 0122082, GB 0122084, and GB 0123844. Hence, the present application has an effective filing date of September 13, 2001, which ante-dates the cited Palmer reference.

### ***Priority***

5. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Great Britain on September 13, 2001 (GB 0122082.1 and GB 0122084.7) and October 4, 2001 (GB 0123844.3). It is noted, however, that applicant has not filed certified copy of said GB application's as required by 35 U.S.C. 119(b).

### ***Claim Rejections - 35 USC § 112***

6. Claim 69 stands rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement as set forth in section 8 of the last Office Action.

7. Applicant has not amended the claim in an attempt to overcome said rejection. Rather, applicant traverses said rejection by asserting Figure 8 and the associated description at pages 9, line 14-page 10, line 5 provides support for the subject matter of claim 69 (Amendment, page 10, 3<sup>rd</sup> paragraph). The examiner respectfully disagrees.

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8. First, to reiterate, claim 69 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which *was not described* in the specification in such a way *as to enable* one skilled in the art to which it pertains, or with which it is most nearly connected, *to make and/or use the invention*. Claim 69 is non-enabled because the specification as originally filed does not teach one skilled in the art how to make the claimed “compressible bubbles” in the upper and lower woven cover layers of the carrier material. Are the “bubbles” created by the construction of the woven structure itself or are said bubbles embossed therein? Or, are said bubbles formed in another manner?

9. Second, it appears applicant has erred in the citation of the specification passage (page 9, line 14 - page 10, line 5), since said citation from the present specification (un-marked version of the substitute specification filed 03/10/04) discusses Figures 4-6 rather than Figure 8. The correct citation should be page 11, line 16 – page 12, line 7.

10. Third, the citation from the specification regarding Figure 8 and its discussion does not enable the subject matter of claim 69. Note the rejection is not a rejection for lack of antecedent basis or support in the specification for the claimed language. Rather, the rejection is made because the specification *does not disclose* to a skilled artisan *how to make* the claimed “compressible bubbles” in the outer woven fabric layers as shown in Figure 8. The specification merely teaches “Hemispherical bubbles 29 are formed in the upper surface 27 and the lower surface 28 which can be axially aligned or offset relative to each other as illustrated.” However, this passage does not explain *how* said bubbles are *formed*. Similarly, the passage “In the case of the carrier shown in Figure 8, the bubbles 29 and the threads 26a therebetween would be filled

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with the dilatant compound...” does not explain *how* said bubbles are *formed*. Therefore, the 112, 1<sup>st</sup> paragraph, lack of enablement rejection for claim 69 is maintained.

***Claim Rejections - 35 USC § 102***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 62-64, and 73 stand rejected under 35 USC 102(b) as being anticipated by GB 2 349 798 issued to Plant as set forth in section 10 of the last Office Action.

Applicant traverses the anticipation rejection by arguing that the amendment “wherein the resilient carrier supports the dilatant material” is sufficient to overcome the Plant reference (Amendment, paragraph spanning pages 10-11). Specifically, applicant asserts the present invention does not have to be sealed within an envelope to support the dilatant material, as is required by the Plant reference. This argument is unpersuasive since it is not commensurate in scope with the rejected claims. Note applicant’s claim language does not necessarily exclude such a ‘sealed envelope.’ The feature upon which applicant relies (i.e., lack of a sealed structure which encapsulates the carrier in order to stop the dilatant material from running away) is not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection of claims 62-64, and 73 by Plant stands.

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13. Claims 62-64, 73, and 74 stand rejected under 35 USC 102(e) as being anticipated by US 6,701,529 issued to Rhoades et al. as set forth in section 12 of the last Office Action.

As with the Plant rejection, applicant argues features which are not presently claimed (Amendment, page 13, 5<sup>th</sup> paragraph – page 14, 2<sup>nd</sup> paragraph). The features upon which applicant relies (i.e., dilatant exiting containment without rupture thereof) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore, the rejection is maintained.

***Allowable Subject Matter***

14. Claims 65-68 and 70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. An updated search of the prior art has been performed. The prior art fails to teach or suggest a resilient carrier with voids or cavities therein, wherein said carrier is coated or impregnated with and supports a dilatant material, and wherein said carrier is a spacer fabric comprising a resilient core sandwiched between a pair of covering layers. Note such a spacer fabric carrier would not have been obvious over the cited Plant and Rhoades references. Additionally, the newly cited art of Budden et al. (WO 2007/102020 A1), which does teach a dilatant impregnated spacer fabric (section [0028]), is not available as prior art since applicant has an effective filing date of September 13, 2001.

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***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached at 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Cheryl Juska/*  
Primary Examiner  
Art Unit 1794

cj  
March 9, 2009